

ESTTA Tracking number: **ESTTA535630**

Filing date: **05/01/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Jockey International, Inc.
Granted to Date of previous extension	05/01/2013
Address	2300 60th Street Kenosha, WI 53140 UNITED STATES
Correspondence information	Lori S. Meddings Michael Best & Friedrich One South Pinckney, St. 700 Madison, WI 53703 UNITED STATES mhburkland@michaelbest.com, lsmeddings@michaelbest.com, mkeipdocket@michaelbest.com Phone:6082573501

Applicant Information

Application No	85595664	Publication date	01/01/2013
Opposition Filing Date	05/01/2013	Opposition Period Ends	05/01/2013
Applicant	The Jockey Club LLC 111 East 56th Street New York, NY 10022 UNITED STATES		

Goods/Services Affected by Opposition

Class 024. All goods and services in the class are opposed, namely: fabrics, namely, fabrics for textile use, cashmere fabric, silk fabrics, wool fabric, nylon fabric, chenille fabric, chiffon fabric, furnishing and upholstery fabrics, fabric window coverings and treatments, namely, curtains, draperies, sheers, swags and valances, hand-towels made of fabrics, interior decoration fabrics; bed and table linens
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	391692	Application Date	06/26/1941
Registration Date	11/18/1941	Foreign Priority Date	NONE

Word Mark	JOCKEY
Design Mark	
Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1934/11/23 First Use In Commerce: 1934/11/23 Underwear, Such as Men's and Boys' Undershirts, Underdrawers, Both With and Without Legs, as Well as [Drawers Having an Abdominal Supporting Band, Union Suits and] Hosiery

U.S. Registration No.	509364	Application Date	10/25/1947
Registration Date	05/03/1949	Foreign Priority Date	NONE
Word Mark	JOCKEY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1934/08/17 First Use In Commerce: 1934/08/17 MEN'S AND BOYS' UNDERWEAR, UNDERSHIRTS, [UNION SUITS,] HOSIERY, [SWIM TRUNKS, SPORT SHORTS,] SPORT SHIRTS, AND T-SHIRTS		

U.S. Registration No.	3258066	Application Date	03/07/2006
Registration Date	07/03/2007	Foreign Priority Date	NONE
Word Mark	JOCKEY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1934/11/23 First Use In Commerce: 1934/11/23 Underwear tops and bottoms; shorts, shirts; active wear, namely, boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, [sweat pants, sweat shirts, sweat shorts, sweat suits,] t-shirts, tank tops, jogging suits, warm-up suits; long underwear; sleepwear; nightwear, pajamas; robes; panties, bras, all-in-ones in the nature of camisoles with built in bras, camisoles, foundation garments, crop tops, stockings, tights and hosiery;[hats and clothing caps, jackets, and; clothing for infants and children, namely, hats, booties, mittens, body suits and rompers]		

U.S. Registration No.	3545069	Application Date	10/11/2004
Registration Date	12/09/2008	Foreign Priority Date	NONE
Word Mark	JOCKEY PERSON TO PERSON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2004/12/03 First Use In Commerce: 2004/12/03		

	Shorts; shirts; active wear, namely, women's sweat pants, sweat shirts, sweat shorts, t-shirts, tank tops; sleepwear; camisoles; jackets; pants; slacks
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Attachments	12872317_NOTICE_OF_OPP-THE_JOCKEY_CLUB.PDF (8 pages)(28395 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/Melissa H. Burkland
Name	Melissa H. Burkland
Date	05/01/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Jockey International, Inc.,

Opposition No. _____

Opposer,

v.

The Jockey Club, LLC,

Applicant.

NOTICE OF OPPOSITION

In the matter of the application for registration of the trademark THE JOCKEY CLUB (“Applicant’s Mark”) for, “fabrics, namely, fabrics for textile use, cashmere fabric, silk fabrics, wool fabric, nylon fabric, chenille fabric, chiffon fabric, furnishing and upholstery fabrics, fabric window coverings and treatments, namely, curtains, draperies, sheers, swags and valances, hand-towels made of fabrics, interior decoration fabrics; bed and table linens” in Class 24 (“Applicant’s Goods”), Serial No. 85/595664, filed April 12, 2012, by The Jockey Club, LLC. (“The Jockey Club” or “Applicant”), and published for opposition in the Trademark Official Gazette of January 1, 2013, Jockey International, Inc., a Wisconsin corporation with its principal place of business at 2300 60th Street, Kenosha, Wisconsin 53141 (“Jockey” or “Opposer”) believes that it would be damaged by registration of the mark shown therein and opposes the same on these grounds:

1. Opposer is the owner of all right, title and interest in the United States to the following trademarks:

Mark	Reg. No.	Reg. Date	First Use Date	Goods or Services
JOCKEY	391692	November 18, 1941	November 23, 1934	Underwear, such as men's and boys' undershirts, underdrawers, both with and without legs, as well, as hosiery.
JOCKEY	509364	May 3, 1949	August 17, 1934	Men's and boys' underwear, undershirts, hosiery, sport shirts, and T-shirts
JOCKEY	3258066	July 3, 2007	November 23, 1934	Underwear tops and bottoms; shorts, shirts; active wear, namely, boxer shorts, bicycle shorts, gym shorts, pants, pullovers, sport shirts, t-shirts, tank tops, jogging suits, warm-up suits; long underwear; sleepwear; nightwear, pajamas; robes; panties, bras, all-in-ones in the nature of camisoles with built in bras, camisoles, foundation garments, crop tops, stockings, tights and hosiery
JOCKEY PERSON TO PERSON	3545069	December 9, 2008	December 3, 2004	Shorts; shirts; active wear, namely, women's sweat pants, sweat shirts, sweat shorts, t-shirts, tank tops; camisoles; jackets; pants; slacks

2. Jockey's trademark registrations listed above (hereafter the "the JOCKEY Family of Marks") constitute conclusive evidence of Jockey's exclusive right to control use of the JOCKEY Family of Marks and similar marks in interstate commerce.

3. Jockey has used the JOCKEY trademark in interstate commerce continuously since at least as early as August 17, 1934, and is currently using the JOCKEY Family of Marks in interstate commerce in connection the goods identified in the above registrations. As such, Jockey has priority of use over Applicant.

4. In addition to the JOCKEY Family of Marks described above, Jockey has common-law trademark rights in many other products in Class 25, such as headwear, which are offered on its website Jockey.com.

5. In addition to use in Class 25, Jockey has historically expanded its use of the JOCKEY Family of Marks far beyond traditional Class 25 goods. Thus, Jockey is more than an apparel company. Jockey moves its business in and out of related product categories, and Jockey owns and has owned registrations for goods in classes such as 14, 18, 20, and 24. Jockey has developed common law rights associated with its use of these marks in connection with goods in these classes.

6. Customers are accustomed to the JOCKEY Family of Marks being used in connection with a wide variety of goods. Jockey, like many other companies that primarily focus on clothing, commonly conducts business in related categories. For example, the Ralph Lauren Corporation has registered the mark RALPH LAUREN for use in connection with “towels, sheets, pillow cases, pillow shams, bed skirts, comforters, blankets, comforter and blanket covers, shower curtains, tablecloths, napkins, textile placemats and fabrics for housewares” in Class 24. (U.S. Reg. No. 1,449,785 for RALPH LAUREN). Calvin Klein, Inc. has similarly registered marks for CALVIN KLEIN in classes beyond its traditional offerings of clothing and undergarments. (U.S. Registration No. 1,226,396 for “sheets, pillow cases, towels, comforters and bedspreads”). Laura Ashley, plc also uses LAURA ASHLEY in connection with

goods and services beyond the clothing and scarves that started the brand. (U.S. Registration No. 1,352,300 for “bed linen and bed and table covers, sheets, pillow cases, shams, comforters, cushion covers; quilts, dust ruffles, cushion covers, precut fabric for patchwork quilts; fabric pieces for blinds and curtains; natural and synthetic textile fabric sold in bulk and the piece, and upholstery fabrics sold in bulk and in the piece”). Thus, consistent with other famous marks in the apparel and textile industry, Jockey has also previously used its famous JOCKEY brand to expand into other classes of goods and services and has previously registered the JOCKEY Mark to use on pillows, comforters, mattress covers, and luggage, among other products.

7. Indeed, consumers are accustomed to seeing large and famous brands such as JOCKEY broaden their product categories to market goods and services beyond the products that initially established the famous brand. As noted above, use of the JOCKEY Mark in a number of different classes is consistent with the offerings of RALPH LAUREN, CALVIN KLEIN, and LAURA ASHLEY, among others.

8. As a result of considerable funds invested in advertising and marketing the goods offered under the JOCKEY Family of Marks, the JOCKEY Family of Marks have enjoyed wide acceptance and popularity in the marketplace and the JOCKEY Family of Marks represents valuable goodwill inuring to the benefit of Jockey. Jockey promotes its goods in print media, on television, on store signage, on www.Jockey.com, and through social media vehicles such as Facebook and Twitter, to name a few.

9. As a result of Jockey’s longstanding use of the JOCKEY Family of Marks, and extensive advertising, promotion and sale of products bearing the JOCKEY Family of Marks, the JOCKEY Family of Marks has achieved widespread recognition.

10. Jockey also owns registrations for the marks JOCKEY.COM, U.S. Registration No. 2,500,535, and JOCKEY, U.S. Registration No. 2,639,847, in connection with offering online and retail store services. Until recently, Jockey owned and used the mark JOCKEY CLUB, U.S. Registration No. 2,160,301 for retail store services, which issued May 26, 1998.

11. Applicant seeks to register the mark THE JOCKEY CLUB (the “THE JOCKEY CLUB Mark”). THE JOCKEY CLUB Mark is confusingly similar to the above JOCKEY Family of Marks as it fully incorporates the JOCKEY trademark. THE JOCKEY CLUB Mark and all of the marks in the JOCKEY Family of Marks all share the one and only distinctive and dominant term “JOCKEY,” thus making THE JOCKEY CLUB mark and the JOCKEY Family of Marks highly similar in sound, appearance, and overall commercial impression. This is particularly true since until very recently Jockey owned and used the mark JOCKEY CLUB in connection with services closely related to Applicant’s Goods.

12. The goods identified in THE JOCKEY CLUB Mark application are “fabrics, namely, fabrics for textile use, cashmere fabric, silk fabrics, wool fabric, nylon fabric, chenille fabric, chiffon fabric, furnishing and upholstery fabrics, fabric window coverings and treatments, namely, curtains, draperies, sheers, swags and valances, hand-towels made of fabrics, interior decoration fabrics; bed and table linens,” in International Class 24 (the “THE JOCKEY CLUB Goods”).

13. Other goods listed in THE JOCKEY CLUB application are so closely related to and overlapping with the JOCKEY Goods, such that THE JOCKEY CLUB Goods are or will be marketed and sold through the same trade channels, placed alongside each other in retail stores, and targeted to the same consumers as Opposer’s JOCKEY Goods.

14. Consumers for Applicant's Goods sold under Applicant's Mark are likely to be confused, mistaken, and deceived as to whether Applicant's Goods originate with or are sponsored, authorized, or licensed by Jockey, all to Jockey's damage.

15. In addition, Applicant's intended use and registration of its mark on or in connection with Applicant's Goods are likely to dilute the distinctive value of Jockey's JOCKEY trademark through blurring or tarnishment.

16. If Applicant is granted the registration herein opposed, it will give Applicant *prima facie* rights to use THE JOCKEY CLUB Mark. Such use and registration would be a source of confusion with Opposer's JOCKEY Mark and cause damage and injury to Opposer.

17. Due to the likelihood of confusion alleged above, Applicant is not entitled to the registration sought, and said registration, if allowed, would be a source of injury and damage to Opposer.

18. The United States Patent and Trademark Office issued an office action on March 30, 2013 refusing registration of THE JOCKEY CLUB "because of a likelihood of confusion with the marks in U.S. Registration Nos. 391692, 509364, 957864, 1715960, 2923495, 2974501, 3258066, 3545069, 3555240, and 3758137."

19. Applicant does not have permission from Opposer to use or register THE JOCKEY CLUB Mark.

20. WHEREFORE, Opposer prays that this Opposition be sustained and the registration sought by Applicant be refused.

Dated this 1st day of May, 2013.

MICHAEL BEST & FRIEDRICH LLP
Attorneys for Jockey International, Inc.

By: /s/ Melissa H. Burkland
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CERTIFICATE OF SERVICES

I hereby certify that a true and correct copy of the Notice of Opposition is being served on Applicant's Correspondent and on the attorney that filed responses on behalf of the Applicant during the prosecution of Applicant's Mark:

DOREEN L. COSTA
BAKER BOTTS LLP
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NEW YORK, NEW YORK 10112-0015
UNITED STATES

on this 1st day of May, 2013.

/s/ Melissa H. Burkland
Melissa H. Burkland